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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/507,510	09/13/2004	Kelly M Aubart	P51325	1144

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EXAMINER

STOCKTON, LAURA LYNNE

ART UNIT	PAPER NUMBER
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1626

DATE MAILED: 01/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/507,510	Applicant(s) AUBART ET AL.	
	Examiner Laura L. Stockton, Ph.D.	Art Unit 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9/13/2004</u> . | 6) <input type="checkbox"/> Other: ____. |

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DETAILED ACTION

Claims 1-3 are pending in the application.

Oath/Declaration

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:
the filing date of Provisional Application
60/364,423 is incorrect. The correct filing date
is March 13, 2002.

Priority

The Provisional application 60/364,423 filed
March 13, 2002 was reviewed because of intervening art.
It was found that Applicants' provisional application

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did not support compounds in which the A variable represents $-C(O)NHOH$. Therefore, compounds where A represents $-C(O)NHOH$ are not afforded the benefit of the filing date of the provisional application but can only rely on the filing date of the International Application which is March 12, 2003.

Information Disclosure Statement

The Examiner has considered the Information Disclosure Statement filed on September 13, 2004.

Claim Objections

Claim 1 is objected to because of the following informalities: in claim 1, "substituents" (page 16, line 15) is misspelled. Appropriate correction is required.

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Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, under the definition of R2, there is a valence problem with the substituent "NC(O)R4" (page 16, line 10). In claim 1, under the definition of the A variable, the "or" should be changed to an "and".

In claim 2, the phrase "or a pharmaceutically acceptable salt thereof" lacks antecedent basis from claim 1.

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Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 and 3 are rejected under 35 U.S.C. 102(a) as being anticipated by:

a) Harris et al. {Acta Crystallographica, Section D : Biological Crystallography (December 2002), D58, (12), pages 2153-2156} - see Compound (c) in Figure 2 on page 2155; or

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b) Chong et al. {WO 2002/28829} - see compound 311 on page 68.

Each of the above cited references disclose a compound that is embraced by the instant claimed invention. Therefore, each reference anticipates the instant claimed invention.

Claims 1 and 3 are rejected under 35 U.S.C. 102(b) as being anticipated by:

a) Jacobsen {U.S. Pat. 5,712,300} - see, for instance, Example 1 on page 20; or

b) Jacobsen {WO 97/32846} - see, for example, Example 23 on page 63.

Each of the above cited references disclose at least one compound that is embraced by the instant claimed invention. Therefore, each reference anticipates the instant claimed invention.

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Claims 1 and 3 are rejected under 35 U.S.C. 102(e) as being anticipated by Chen et al. {U.S. Pat. 6,825,215}.

Chen et al. disclose, for example, the compound in column 11, lines 47-49, which is embraced by the instant claimed invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jacobsen {U.S. Pat. 5,712,300}, Jacobsen {WO 97/32846} and Chen et al. {U.S. Pat.

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6,825,215}, each taken alone or in combination with each other when similar utilities are asserted.

*Determination of the scope and content of the prior art (MPEP
§2141.01)*

Applicants claim imidazolone and pyrrolone compounds. Jacobsen '300 (columns 2-5; column 18, lines 3-18; and especially Example 1 on page 20), Jacobsen '846 (pages 1-7; and especially Example 23 on page 63) and Chen et al. (columns 4-6; column 12; and especially the compound in column 11, lines 47-49) each teach compounds that are either structurally the same as (see above 102 rejections) or structurally similar to the instant claimed compounds.

*Ascertainment of the difference between the prior art and the claims
(MPEP §2141.02)*

The difference between some of the compounds of the prior art and the compounds instantly claimed is that some of the instant claimed compounds are generically described in the prior art.

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***Finding of prima facie obviousness--rational and motivation (MPEP
§2142-2413)***

The indiscriminate selection of "some" among "many" is *prima facie* obvious, *In re Lemin*, 141 USPQ 814 (1964). The motivation to make the claimed compounds derives from the expectation that structurally similar compounds would possess similar activity (e.g. an anti-bacterial)..

One skilled in the art would thus be motivated to prepare products embraced by the prior art to arrive at the instant claimed products with the expectation of obtaining additional beneficial products which would be useful in treating, for example, bacterial infections. Since each of the prior art teach similar compounds to each other and are used to treat some of the same ailments, the combination of the prior art references would also teach the instant claimed invention. The instant claimed invention would have been suggested and

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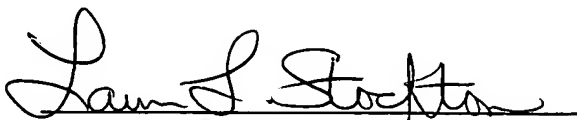
therefore, obvious to one skilled in the art. A strong case of *prima facie* obviousness has been established.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura L. Stockton whose telephone number is (571) 272-0710. The examiner can normally be reached on Monday-Friday from 6:15 am to 2:45 pm. If the examiner is out of the Office, the examiner's supervisor, Joseph McKane, can be reached on (571) 272-0699.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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The Official fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

A handwritten signature in black ink, reading "Laura L. Stockton". The signature is written in a cursive style with a horizontal line underneath the name.

Laura L. Stockton, Ph.D.

Patent Examiner

Art Unit 1626, Group 1620

Technology Center 1600

January 23, 2006